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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/797,949	03/10/2004	Gerald J. Van Handel	12244 CIC1	4840

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PATENT GROUP GA030-43  
GEORGIA-PACIFIC CORPORATION  
133 PEACHTREE STREET, N.E.  
ATLANTA, GA 30303-1847

EXAMINER

ELKINS, GARY E

ART UNIT

PAPER NUMBER

3727

DATE MAILED: 05/05/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/797,949

Applicant(s)

VAN HANDEL, GERALD J.

Examiner

Gary E. Elkins

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,3,5,7-16,18-20,22-24,26 and 27 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3,5,7-16,18-20,22-24,26 and 27 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. ____.  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>20040310</u> .  | 6) <input type="checkbox"/> Other: ____.                                    |

## DETAILED ACTION

### *Double Patenting*

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1, 3, 5, 7-15, 19, 23 and 27 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1 and 2 of U.S. Patent No. 6,536,657 in view of Neale et al. Claims 1, 3, 5, 7-15, 19, 23 and 27 are narrower than patent claims 1 and 2 insofar as the application claims define a container blank for a truncated cone shaped sidewall portion of a disposable paper cup whereas claims 1 and 2 of the patent define a container. Neale et al teaches that it is known to make an insulated container using a laminated blank designed to form a truncated cone shaped sidewall of a disposable paper cup. It would have been obvious to make the container defined in patent claims 1 and 2 using a laminated blank designed to form a truncated cone shaped sidewall of a disposable paper cup as taught by

Neale et al as a mere selection of what type of container/blank one wishes to make the container of the patent from. Laminated paper cup blanks are well known in this art. The conflicting claims are otherwise not patentably distinct from one another because, other than the limitations noted above, all the elements in each of claims 1, 3, 5, 7-15, 19, 23 and 27 of the application are found in claims 1 and 2 of the patent. The difference, other than the limitations noted above, between the application claims and the patent claims lies in the fact that the patent claims include more elements and are thus more specific. The invention, other than the above noted limitations, in the patent claims are in effect species of the generic invention of each of the application claims. It has been held that the generic invention is anticipated by the species. See *In re Goodman*, 29 USPQ2d 2010 (Fed. Cir. 1993). Since each of the application claims, exclusive of the above noted limitations, is anticipated by the patent claims, they are not patentably distinct therefrom.

3. Claims 1, 3, 5 and 7-15 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-3 of U.S. Patent No. 6,729,534 in view of Neale et al. Claims 1, 3, 5 and 7-15 are narrower than patent claims 1-3 insofar as the application claims define that the blank is for a truncated cone shaped sidewall portion of a disposable paper cup whereas claims 1-3 of the patent define a container blank. Neale et al teaches that it is known to make a laminated blank to form a truncated cone shaped sidewall of a disposable insulated paper cup. It would have been obvious to make the container defined in patent claims 1-3 using a laminated blank designed to form an insulated truncated cone shaped sidewall of a disposable paper cup as taught by Neale et al as a mere selection of what type of blank one wishes to make the blank of the patent from. Laminated paper cup blanks designed t

form insulated cups are well known in this art. The conflicting claims are otherwise not patentably distinct from one another because, other than the limitations noted above, all the elements in each of claims 1, 3, 5 and 7-15 of the application are found in claims 1-3 of the patent. The difference, other than the limitations noted above, between the application claims and the patent claims lies in the fact that the patent claims include more elements and are thus more specific. The invention, other than the above noted limitations, in the patent claims are in effect species of the generic invention of each of the application claims. It has been held that the generic invention is anticipated by the species. See *In re Goodman*, 29 USPQ2d 2010 (Fed. Cir. 1993). Since each of the application claims, exclusive of the above noted limitations, is anticipated by the patent claims, they are not patentably distinct therefrom.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 7-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Inagaki in view of Smith. Inagaki discloses a blank (fig. 14) for making the sidewall of a conical paper container including a substrate layer and a connected shrink film layer. Inagaki does not disclose a blank for a truncated cone shaped cup. Smith teaches that it is known to make a blank for making a container or cup with a frustro-conical shape as opposed to a conical shape. It would have been obvious to make the blank in Inagaki for a cup with a frustro-conical shape as taught

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by Smith to allow nesting of multiple like containers prior to use/to enhance storage and transport.

6. Claims 1, 3, 5, 7-16, 18-20, 22-24, 26 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yawata in view of Neale et al. Yawata discloses a frustro-conical cup including a substrate layer and at least one film (21 or 22) connected thereto and adapted to shrink away from the substrate layer as claimed and/or adapted to insulate the container during use. Yawata does not disclose attachment of the shrink film to the sidewall blank (prior to formation of the cup). Neale et al teaches that it is known to provide attachment of a lamination on a cup prior to formation of the cup, i.e. to provide attachment to a blank. It would have been obvious to attach the film in Yawata to the sidewall blank prior to formation of the cup sidewall as taught by Neale et al to allow erection of the cup from the blank at a different location and time than when the laminate is formed. The formation of laminated container structures prior to erection of the container is a well known concept in this art. With respect to claims 16, 19, 20, 23, 24 and 27, it is noted that the air pockets shown in Yawata are considered to be both horizontally and vertically oriented since they have both component length and height dimensions.

### *Conclusion*

The remaining newly cited prior art is illustrative of the general state of the art.

In order to reduce pendency and avoid potential delays, Technology Center 3700 is encouraging FAXing of responses in Office Actions to (571)273-8300. This practice may be used for filing papers not requiring a fee. It may also be used for filing papers which require a

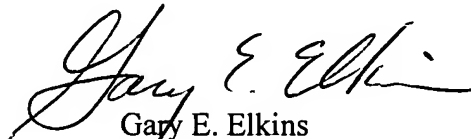
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fee by Applicants who authorize charges to a PTO deposit account. Please identify the Examiner and art unit at the top of your cover sheet.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. Also, copies of an office action or other file information may be obtained from the Private PAIR system. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions regarding access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any inquiry concerning this communication or earlier communication from the Examiner should be directed to Gary Elkins at telephone number (571)272-4537. The Examiner can normally be reached Monday, Tuesday and Thursday.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Mr. Nathan Newhouse can be reached at (571)272-4544.

  
Gary E. Elkins  
Primary Examiner  
Art Unit 3727

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01 May 2006